

REMARKS

I. OVERVIEW

Claims 1-20 are pending in the present application. The present response is an earnest attempt to place the application in form for allowance. Reconsideration is respectfully requested.

II. OBJECTION TO SPECIFICATION

The Abstract has been revised to convert it to one paragraph. The following changes to the specification have been made to remedy the Examiner's objections:

- A. Page 2 has been amended to include the specification relation-back paragraph.
- B. The Abstract has been converted from two paragraphs to one paragraph.

Please note that a minor, inadvertent grammatical correction has been made at page 22 of the specification.

III. DRAWINGS

Accompanying this response are replacement drawing sheets for Figures 1-3. They remove any blurred numbers or text. Each has been labeled as a replacement sheet.

IV. CLAIM OBJECTIONS

Claims have been revised to remedy the objections as follows:

- A. The first period in claim 1 has been deleted.
- B. Claim 11 has been amended to change the punctuation in a manner which is submitted to be appropriate. The unintentional misspelling in line 10 has been corrected as suggested by the Examiner.
- C. In claim 10, the word "one" has been changed to the numeral "1" as required by the Examiner.

It is respectfully submitted all claim objections have been remedied.

V. § 101 REJECTION

Claims 1-10 and 16-20 are rejected under 35 U.S.C. § 101. The position of the Office Action is that these claims are not eligible for patentability, as they do not fit into any statutory classification for patents. This rejection is respectfully traversed.

First, Applicant respectfully disagrees with the test articulated for determining § 101 subject matter.

Second, Applicant respectfully submits additional language need not be added to the claims to make them statutory (for example, any explicit recitation of utilization of a computer). Independent claim 1 is a method claim. It is not an apparatus claim. Furthermore, claim 1 explicitly recites the following steps which are explicit, concrete, useful, and tangible actions:

- (1) provide an instructional help to a user of an instructional program¹ and
- (2) presenting an interactive instructional program to the user,
- (3) presenting, at selected times instructional help options to the user,
- (4) information presented to the user in the form perceivable by the user.

Third, it is respectfully submitted that claim 1 meets statutory subject matter as defined by the Courts. The mere step of presenting an interactive instructional program and information in a form perceivable by the user is sufficiently concrete, tangible activity to meet statutory subject matter.

The Examiner is directed towards the most recent U.S. Supreme Court authority of patent-eligible subject matter, JEM Ag Supply, Inc. v. Pioneer Hi-Bred International, Inc., 534 U.S. 124, 122 S.Ct. 593 (2001), interpreting the language of 35 U.S.C. § 101 to be extremely broad. The Supreme Court also recognized that the § 101 is a dynamic provision designed to encompass new unforeseen inventions. 35 U.S.C. § 101 means what it says when it defines "any

¹ "All elements of the claim must be considered, including the preamble, since limitations appearing in the preamble are necessary to give meaning to the claim and to properly define the invention." Corning Glass Works v. Sumitomo Electric, 9 U.S.P.Q.2d 1962 (Fed. Cir. 1989); in re Poulsen, 31 U.S.P.Q.2d 1671, 1673 (Fed. Cir. 1994).

new and useful process" as being patent-eligible subject matter and the categories of § 101 are not limiting. See, e.g., JEM Ag Supply at 598 (citing to Diamond v. Chakrabarti, which held that anything "under the sun" made by man is eligible for patenting under § 101). To the extent that the Examiner's test is inconsistent with JEM Ag Supply, Inc., it is simply overruled or not controlling.

Claims 2-10 are dependent from claim 1 and are submitted to be statutory for the same reasons.

Claim 16 is an apparatus claim. The term "system" is ubiquitously used in apparatus claims. But moreover, it defines a concrete, useful and tangible apparatus. Not only does it define a "interactive learning system", it specifies (1) audio-visual information on a CDROM". Thus it defines subject matter under § 101. Whether or not it is a patentable "technological dance" is not a § 101 test, but a § 102 or § 103.

Claims 17-20 are dependent from claim 16 and are submitted to be statutory for the same reasons.

§ 112 REJECTIONS

Each of claims 7-9 has been rejected as indefinite, as being in improper Markush format. Each of those claims has been amended to eliminate the Markush-type invocation and substitutes "at least one or more" before the list of following attributes. It is respectfully submitted this is definite and does not require the Markush format.

§ 102 REJECTION

Claims 1-4, 9-11 and 14 have been rejected as anticipated by Hatakama, U.S. Patent 5,774,118. This rejection is respectfully traversed.

A *prima facie* case of anticipation must present a reference (a) that discloses, with substantial identity, (b) each of the critical elements in the claim in the arrangement of the claim, as interpreted by one of ordinary skill in the art. Hatakama is not an instructional system or

method. It is limited to display of help information with respect to operation of a device.

Column 1, lines 7-12. Essentially it is a conventional help database for the purpose of resource material for the user of a computer instead of having to refer to an operations manual.

In contrast, Applicant's claimed invention relates to an instructional program -- where the user is trying to learn subject matter. The remainder of the claim speaks to presenting information as a part of the learning process of the instructional program.

In the table below, differences between Applicant's claims and Hatakama are set side-by-side:

Hatakama	McKirchy
System determines skills level of user (Abstract)	User selects level of sophistication desired without limitation within each section; user can select multiple levels in each section if desired
System classifies operations and checks development of user skills and then makes help options available to user (Col 2 line 43-45); System allows selection of skill level at the operation level only (Fig 4)	User selects level of sophistication desired without limitation within each section of instructional content; user can select multiple levels in each section of the instructional content if desired
Help documents presented describe operations and concepts on the use of the device (col 2 line 53)	Levels of sophistication are not limited to operations and concepts
Help documents are presented at entry level, intermediate level and proficient level (Fig 2)	Levels of sophistication can be presented at an unlimited number of levels; multiple levels of sophistication can be accessed by the user in each section if desired

Help display customization is limited to entry level, intermediate level and proficient level in operations only (Fig.4)	Users can customize their learning experience by choosing any or all of the levels of sophistication presented in any order at any time; levels of sophistication are not limited to operations of a device or software but are unlimited in number, type and application
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Thus, Hatakama does not provide a *prima facie* case of anticipation as it does not have substantial identity with the critical elements of the claims in their arrangement and as interpreted by one of ordinary skill in the art.

Each of the independent claims 1, 11, and 16 have similar language. It is therefore respectfully submitted they are not anticipated by Hatakama. Claims 2-4, 9, 10, 14 are dependent from one of those independent claims and therefore are submitted to be not anticipated for the same reasons.

Although Applicant traverses the rejection under § 102 based on the original claim language, to advance prosecution of the present application, Applicant has focused the independent claims on an aspect of allowing the user to have access to different levels of sophistication of additional instruction for at least some of the sections and that the levels of sophistication can vary between such sections. As discussed above, Hatakama does have three levels of help but the system decides which level is appropriate for the user. The user cannot explore the different levels. Also, there is no variance of the levels between sections.

The importance of these features is described in Applicant's specification. When learning subject matter, it has been found helpful to have additional instruction assistance, and that the learner be allowed to select more sophisticated instructional assistance in certain circumstances and less in certain circumstances. The goal of the Applicant's application is the most efficient learning of the student. Hatakama has no disclosure of the combination of amended claim 1. Therefore, it is patentably distinct from Hatakama.

OBVIOUSNESS REJECTIONS

Claims 5-8, 12-13, 15-20 have been rejected as obvious based on Hatakama in combination with Cook, U.S. Patent 5,727,950. This rejection is respectfully traversed.

Claims 5-8, 12-13, 15, and 17-20 are dependent from one of the independent claims previously discussed and therefore are submitted to be allowable as being dependent from those claims.

Moreover, Cook does not have any teaching or suggestion which bridges the gap between the missing disclosure or teaching of Hatakama and the Applicant's claims.

For *prima facie* case of obviousness, the references must (a) teach a reason, suggestion or motivation to combine or modify themselves, (b) in a manner that appears to show or suggest the claimed invention to one of ordinary skill in the art.

First, it is respectfully submitted that Cook is not legal prior art to the present invention. The enclosed declaration of Karen McKirchy is filed under 37 C.F.R. §1.132 to establish conception of the invention at a date prior to the earliest effective prior art date of Cook and diligence in moving the conception to a reduction to practice from that date up until the day before Cook's earliest date, its filing date. As such, it is respectfully submitted Applicant has sworn behind Cook and it should be removed as a reference and the § 103 rejection should be withdrawn.

Even if Cook is applied as a reference, it does not present a *prima facie* case of obviousness in combination with Hatakama. Cook is very specific in its teaching of a tutoring system that has characters in its database. However, it specifically diverges from the Applicant's invention in its requirement that one tutor is assigned to each student. In other words, it attempts to simulate real life, where a student is assigned a specific tutor. That tutor would then have one persona, one method of teaching, and one level of sophistication. The table below further contrasts Cook:

Cook	McKirchy
Invention includes an agent for each student (Abstract); Claim 86c Col 73 line 1 “one or more agents executable on said one or more computers, each said agent associated with exactly one of said students and each said student associated with exactly one of said agents”	The user is not restricted to one treatment as Cook restricts each student to one agent; different levels of sophistication are available to the user across instructional sections; levels of sophistication are not restricted to being assigned an agent role but may utilize a wide variety of treatments in an unlimited combination

As seen, Applicant's claims specifically are directed towards a learning system where the student can select between different levels of sophistication to help his/her learning process. The contrast is explicit and material. As described in Applicant's specification, it is that ability that has been found to be very effective to help individual students master a learning task.

Therefore, it is respectfully submitted that there is no suggestion, teaching, or motivation to combine Hatakama and Cook. However, even if combined, all Cook adds is that there might be some persona or animation of a particular type of tutor for a particular person invoking help screens when operating a device to help in operation of that device. It does not teach or suggest Applicant's claims.

It is therefore respectfully submitted that claims rejected under § 103 are not obvious and a *prima facie* case is not made out under the combination of Hatakama and Cook.

As described earlier, Hatakama has no disclosure of allowing exploration of multiple levels of sophistication by the learner or varying the number and type of levels between different sections to facilitate learning. Cook likewise has no such teaching. It basically matches the hypothetical tutor to a student. It speaks nothing of allowing the student to explore various levels of sophistication of additional instruction or varying the levels or type between different sections the student is trying to learn. Thus, Cook does not teach what is missing from Hatakama. The only teaching of Applicant's claims is through hindsight gained by Applicant's claims.

Still further, the U.S. Supreme Court has instructed that secondary indicia of non-obviousness must be considered when evaluating obviousness. The enclosed declaration of Karen A. McKirchy is respectfully submitted under 37 C.F.R. § 1.132 as rebutting obviousness of the claims.

It establishes commercial success of the invention. Numerous agencies of the U.S. Government use it every day. The number of hits on the website that it uses the instructional assistance according to the invention is substantial.

Moreover, the invention is licensed to a number of entities including various U.S. Government agencies. This establishes acquiescence in the merits of the invention in the market place.

For these additional reasons, it is respectfully submitted the claimed invention is patentable over the cited art.

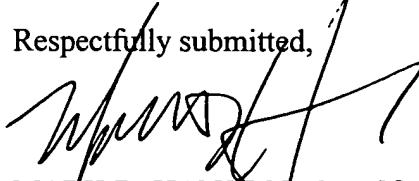
CONCLUSION

It is respectfully submitted all matters raised in the Office Action have been addressed and remedied and that the Application is in form for allowance. An allowance is respectfully requested.

This is a request under the provision of 37 CFR § 1.136(a) to extend the period for filing a response in the above-identified application for three months from April 13, 2005 to July 13, 2005. Applicant is a small entity; therefore, please charge Deposit Account number 26-0084 in the amount of \$510.00 for three months to cover the cost of the extension. Any deficiency or overpayment should be charged or credited to Deposit Account 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



MARK D. HANSING, Reg. No. 30,643
McKEE, VOORHEES & SEASE, P.L.C.
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
Phone No: (515) 288-3667
Fax No: (515) 288-1338
CUSTOMER NO: 22885

Attorneys of Record

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Encls.: Replacement Drawing Sheets (Figures 1-3--three sheets)
Declaration of Karen A. McKirchy (and Exhibits A-C)

IN THE DRAWINGS

Accompanying this response are replacement sheets for Figures 1-3.